

Appl. No. 09/935,895
Amendment and/or Response
Reply to Office action of 8 May 2003

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REMARKS / DISCUSSION OF ISSUES

Claims 6-11 are pending in the application.

Applicant(s) thank(s) the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority document(s).

The Office action objects to the drawings and requires labeling FIG. 3 as prior art, and including reference label 15. These changes having been made, withdrawal of the objection to the drawings is respectfully requested.

The Office action rejects claims 6-8 and 10 under 35 USC § 103(a) over applicants' FIG. 3 in view of Saito et al. (JP 3-241801). Applicants respectfully traverse this rejection. As explained below, claims 6 and 10, and therefore also claims 8, 9, and 11 that depend directly or indirectly from independent claim 6, are patentable over any permissible combination of the cited reference(s).

Claim 6-11 are patentable at least because neither FIG. 3 nor Saito et al. teach or suggest the homogeneously distributed synthetic resin having a concave surface as recited in independent claims 6 and 10. The Office action asserts that "Saito et al. inherently discloses a concave/convex surface at the spacer." However, the Office action provides no evidence to support this assertion, nor points to anywhere in the cited reference where the recited concave surface of the synthetic resin is taught or suggested. The assertion that Saito et al. inherently discloses a concave/convex surface appears to be complete conjecture.

To establish inherency, an examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP 2112. However, the Office action does not provide any objective evidence or cogent technical reasoning to support the conclusion of inherency. Accordingly, this feature cannot be shown to be inherent in the cited reference, and the rejection of claims 6-8 and 10 under 35 USC § 103(a) should be withdrawn.

Additionally, the Office action plans to no motive or teaching in any prior art reference that would cause one of ordinary skill in the art to combine the spacer filling material of Saito et al. with the ring-shaped core of FIG. 3. A factual question

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of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. A bald statement that it "would have been obvious to combine" with no rationale in support of this assertion, is certainly insufficient to show motivation under 35 USC § 103(a). Accordingly, the rejection of claims 6-8 and 10 under 35 USC § 103(a) should be withdrawn for this reason as well.

The Office action rejects claims 9 and 11 under 35 USC § 103(a) as above and further in view of U.S. Pat. No. 6,246,172 to Bizen et al. Applicants respectfully traverse this rejection. Claims 9 and 11 are patentable at least because they depend from independent claim 6 which is patentable as explained above. Additionally, the two references cannot be combined because there is no motivation in either reference to use the resin of Saito et al. in a two-gap core such as in Bizen et al., for reasons that are readily apparent one of ordinary skill in the art. Accordingly, the rejection of claims 9 and 11 under 35 USC § 103(a) should be withdrawn for this reason as well.

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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